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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,666	02/12/2002	Thomas P. Griego	31248-3	6124
5179	7590	12/19/2003	EXAMINER	
PEACOCK MYERS AND ADAMS P C			NICOLAS, WESLEY A	
P O BOX 26927			ART UNIT	PAPER NUMBER
ALBUQUERQUE, NM 871256927			1742	

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,666

Applicant(s)

GRIEGO, THOMAS P.

Examiner

Wesley A. Nicolas

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 8-14 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6/20&28/02.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This is in response to the response to the restriction requirement submitted November 3, 2003. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-14 are currently pending in this application, with claims 8-14 drawn to a non-elected invention.

Election/Restriction

1. Claims 8-14 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the Paper submitted November 3, 2003.

The argument by Applicant that the claim groupings should be examined together has been considered, however it is not convincing. Applicant asserts that it is "unlikely" that sintering technology could achieve the results of Applicant's invention. Applicant further asserts that there is very little additional effort to search the claim groupings together. In response, Examiner must respectfully disagree. Just because one process of forming an encapsulated power is "unlikely" to form Applicants invention is not enough to keep both the inventions together. Additionally, burden on the Examiner is not the only consideration when determining whether or not claims should be examined together. Here, Applicant is claiming two patentably distinct inventions, namely a method and a product/product-by-process. The product/product-by-process

claims are in an examination area wholly different than that searched by the Examiner, therefore there would be a burden on the Examiner in searching those claims.

Furthermore, since Applicant has not provided express admission that the claimed inventions are indistinct as required by Lee, the restriction as set forth in the previous Office action has been maintained. In re Lee, 199 USPQ 108 (Deputy Asst. Comm'r. for Pats 1978). The restriction is hereby being made **FINAL**.

Allowable Subject Matter

2. Claims 1-7 are allowed over the prior art of record.
3. The following is a statement of reasons for the indication of allowable subject matter:

The specific method of producing metal hydride misch-metal composite powders, comprising:

- providing to a rotary flow through electrodeposition apparatus a powder whose particles comprise one or more lanthanide alloy metal selected from the group of titanium lanthanide alloy metals and nickel lanthanide alloy metals; and
- electrodepositing one or more non-lanthanide metals on the powder via the apparatus was not taught or suggested by the prior art of record.

It should be noted that the closest prior art was that of Griego (U.S. 5,565,079 - cited by Applicant) but it is generic with respect to the specific powder used and metal electrodeposited onto the powder.

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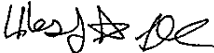
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley Nicolas whose telephone number is (703) 305-0082 up until 12/16/03 and (571) 272-1247 thereafter. The examiner can normally be reached on Mon.-Thurs. from 7am to 5pm.

The Supervisory Primary Examiner for this Art Unit is Roy King whose telephone number is (703) 308-1146 up until 12/16/03 and (571) 272-1244 thereafter.

The fax number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.


WESLEY A. NICOLAS
PATENT EXAMINER

December 8, 2003